

**REMARKS****Status of the Claims**

Upon entry of the amendment above, claims 14-44 and 46-61 will remain pending, claims 14, 15, 29, 30, 44, and 58 being independent.

**Summary of the Office Action**

Claims 14, 49, and 50 are rejected under 35 USC §112, first paragraph, as allegedly failing to comply with the written description requirement thereof.

Claims 14-18, 20-23, 25, 26, 28, 49, and 50 are rejected under 35 USC §102(b) as being anticipated by ELLIS et al. (U.S. Patent No. 3,206,874, hereinafter "ELLIS").

Claims 14-18, 20-22, 25, 26, 28, 49, and 50 are rejected under 35 USC §102(b) as being anticipated by O'DONNELL (U.S. Patent No. 3,068,593).

Claims 14 and 49 are rejected under 35 USC §102(b) as being anticipated by EDWARDS et al. (U.S. Patent No. 3,334,427, hereinafter "EDWARDS").

Claims 19 and 27 are rejected under 35 USC §103(a) as being unpatentable over ELLIS in view of CATAFFO (U.S. Patent No. 2,249,553).

Claim 19 is rejected under 35 USC §103(a) as being unpatentable over O'DONNELL in view of CATAFFO.

Claims 15, 18-20, 22, 26-31, 33, 35, 38-44, 48, and 50-61 are rejected under 35 USC §103(a) as being unpatentable over EDWARDS in view of CATAFFO.

Claims 16, 17, 21, 23, 25, 36, 37, 46, and 47 are rejected under 35 USC §103(a) as being unpatentable over ELLIS in view of ELLIS; over O'DONNELL in view of ELLIS; over EDWARDS in view of CATAFFO and ELLIS.

Claims 32 and 34 are rejected under 35 USC §103(a) as being unpatentable over EDWARDS in view of CATAFFO and LANDRY (FR 2361837).

Claim 24 is identified as containing allowable subject matter, but is objected to for depending from rejected claims.

**Response to the Office Action**

**A. Withdrawal of Rejection Under 35 USC §112, First Paragraph**

Applicant requests that the rejection for alleged failure to comply with the written description requirement of 35 USC §112, first paragraph, be withdrawn.

The Examiner has taken the position that there is no support for the following limitation in claim 14: "said rigid or semi-rigid cover being more rigid than said upper front surface and said flexion fold zone of the shoe so as to interfere with free flexing of the shoe while a wearer's foot is positioned within the shoe."

The disclosure is clear that the invention is directed to increasing the flexural rigidity of a shoe. See, for example, paragraphs 0001 and 0027 of the specification

In paragraph 0030 it is explained that a cover 1 covers the front portion of the shoe (the "front portion" being identified in paragraph 0030 as "the front of the shoe 10, from its tibial support zone 20 up to its front end zone 22, including the flexion fold zone 21").

Paragraph 0028 specifies that "the front portion of the boot can be flexible". Paragraph 0001, *e.g.*, specifies that the cover can be "rigid or semi-rigid" so as to stiffen the front surface of the shoe.

Therefore, Applicant submits, at the time the application was originally filed, Applicant had in his possession the disclosure that the *rigid or semi-rigid* cover is more rigid than the *flexible* front portion of the boot, particularly inasmuch as the original disclosure makes clear that it is the flexibility of the front portion of the boot which is desired to be rigidified by the cover so as to stiffen the front surface of the shoe.

**B. Summary of the Invention**

The invention is directed to an article of footwear and, in a particular embodiment, a shoe that includes a high upper, *i.e.*, an upper that extends above the ankle of the wearer and which is positioned along the lower leg of the wearer, such as in front of the tibia of the wearer.

A particular field of endeavor to which the invention is directed is that of snowboarding. As explained in the background and summary sections of the specification of the instant application, current snowboard boots (and other sports boots) must satisfy various demands of the user, some of which are contradictory. For example, a boot should be comfortable for the user and, for example, should enable him/her to perceive plantar sensations during the sport, *i.e.*, during snowboarding. On the other hand, if the upper of the boot is not sufficiently rigid, the transmission of forces from the rider to his/her board is less than optimum.

According to the invention, then, at least the front-to-rear rigidity of the boot is enhanced by means of a cover, *i.e.*, a front spoiler, whereby the tibial support zone of the boot is less easily flexed about the flexion fold (*i.e.*, the flexion crease) of the boot toward the front end zone of the boot. Thus, with the cover in place on the boot, in which the cover extends from at least the front end zone of the boot and into the flexion fold zone, the cover interferes with the free flexing of the boot that would be possible without the cover.

**C. Withdrawal of Rejections Under 35 USC §102 and §103**

Applicant requests that the various grounds of rejection under 35 USC §102 and §103 be reconsidered and withdrawn.

Initially, Applicant will address the rejection of claims 15, 18-20, 22, 26-31, 33, 35, 38-44, 48, and 50-61 under 35 USC §103(a) as being unpatentable over EDWARDS in view of CATAFFO, inasmuch as these claims are not otherwise rejected.

In addition, although Applicant submits that there are additional reasons in support of the allowance of certain dependent claims, Applicant presents below arguments relating to the independent claims.

1. **Applicant's Invention Would Not Result from a Combination of EDWARDS and CATAFFO**

a. **Claim 58**

First, independent claim 58 is directed to a "snowboard boot assembly" which includes, *inter alia* (prior to consideration of the proposed amendment above), "a front spoiler for increasing rigidity of flexion of said upper at least in said flexion fold zone for improving transmission of forces from the snowboarder to the snowboard, said cover extending in said tibial support zone, said front end zone and said flexion fold zone."

EDWARDS (as well as each of ELLIS and O'DONNELL) is directed to improvements in "safety shoes". A shoe is disclosed that is fitted with a guard flap that is positioned over the toe and metatarsal area of the shoe.

EDWARDS discloses a shoe 10 including a cover 22 that has a rigid shell 23, at the upper end of which a leather loop 25 is fastened by a rivet 26. This means that one part 23 of the cover 22 is rigid, and that another part 32 of the cover is relatively soft/flexible. In fact, in column 1, lines 52-55, and column 2, lines 56-59, EDWARDS explains that the "splash guard" is made from "a piece of *flexible leather*."

Because claims 29-49 and 52-61 were not susceptible to rejection on any other ground, the Office action relies upon a hypothetical combination of EDWARDS and CATAFFO. That is, the reliance upon CATAFFO evidences the recognition that EDWARDS fails to teach a rigid or semi-rigid cover that extends within the zone of the flexion fold, nor within the tibial support zone. Regarding Applicant's claim 58, neither EDWARDS nor CATAFFO teach or suggest a "front spoiler."

More specifically regarding CATAFFO, an "ankle and lower leg shield 14" is described which projects upwardly from the front of the instep-covering portion 13. However, the shield 14 is "sufficiently forwardly spaced from the front of the shoe to accommodate the trousers of the worker and provide a required amount of freedom of movement between the shield and the leg of the worker" (left column, lines 49-53).

By forwardly spacing the shield to accommodate the trousers, then, CATAFFO cannot possibly be concerned with nor provide any provision for "*increasing rigidity of flexion*" of the upper and for "*improving transmission of forces between the snowboarder and the snowboard*", as expressed in Applicant's claim 58.

Further, Applicant submits that the shield 14 of CATAFFO is not "in said flexion fold zone," nor does it extend in the tibial support zone, as specified by Applicant, since *the shield of CATAFFO is spaced therefrom*.

Still further, in the proposed amendment to claim 58 above, Applicant specifies that the front spoiler is "removably attached to said upper." The cover of CATAFFO is only attached to the sole.

**b. Claim 44**

Independent claim 44 is also directed to a "snowboard boot assembly" which includes, *inter alia* (prior to consideration of the proposed amendment above), "a cover for increasing flexural rigidity of said snowboard boot, said cover being attached to said front end zone of said snowboard boot and extending rearwardly to cover said flexion fold zone."

As with regard to claim 58, by forwardly spacing the shield to accommodate the trousers, then, CATAFFO cannot possibly be concerned with nor provide any provision for "*increasing flexural rigidity*" of the snowboard boot", as expressed in Applicant's claim 44.

Still further, in the proposed amendment to claim 44 above, Applicant calls for "removable connections for connecting said cover at said flexion fold zone and/or at said portion

extending above said ankle zone," which encompass, *e.g.*, straps 13 shown in Applicant's Figs. 4 and 5.

c. **Claim 30**

Independent claim 30 is directed to an assembly that includes an article of footwear and "a device for increasing rigidity in flexion at least of said upper front zone folding toward said front end zone."

The combination of EDWARDS and CATAFFO would not have provided such a device.

That is, by forwardly spacing the shield to accommodate the trousers, CATAFFO cannot possibly be concerned with nor provide any provision for "*increasing rigidity in flexion at least of said upper front zone folding toward said front end zone.*"

Instead, the upper front zone of the top of CATAFFO's shoe would move toward the front end zone *without any modification of flexion* because the shield 14 is spaced forward of the upper front zone.

Still further, in the proposed amendment to claim 30 above, Applicant calls for "at least one of said intermediate and upper parts of said cover being connected to said upper of said article of footwear." Of course, there is no connection between the upper and the intermediate or upper parts of the shield 14 of CATAFFO.

d. **Claims 15 and 29**

Although Applicant would take issue with whether the shield 14 of CATAFFO could be said to "cover" flexion fold or tibial support zones (inasmuch as the shield is clearly spaced forwardly so as not to interfere with these zones), specified in independent claims 15 and 29, Applicant has proposed amendments to these two claims which refer to connections for connecting the cover to the sole and to the upper (or to the tibial support zone) of the shoe. For reasons advanced above, it would be contrary to the teachings of CATAFFO to so connect his shield 14.

2. **Applicant's Invention Would Not Result from a Combination of EDWARDS and CATAFFO**

In addition to the reasons for allowance of claims that are rejected over a combination of EDWARDS and CATAFFO given above, Applicant submits that the combination proposed in the rejection would not be considered by one skilled in the art, since the modification of EDWARDS by means of the teachings of CATAFFO would require a modification that is contrary to the teachings of EDWARDS.

As explained in *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), a proposed modification is inappropriate as a consideration regarding obviousness under 35 USC 103 when such modification would render the prior art reference inoperable for its intended purpose.

EDWARDS discloses a shoe 10 including a cover 22 that has a rigid shell 23, at the upper end of which a leather loop 25 is fastened by a rivet 26. See column 2, lines 33-41. This means that one part 23 of the cover 22 is rigid, and that another part 32 of the cover is relatively soft/flexible.

In fact, in column 1, lines 52-55, and column 2, lines 56-59, EDWARDS explains that the "splash guard" is made from "a piece of *flexible leather*."

In addition to the splash guard 32 of EDWARDS not being semi-rigid or rigid, it would be contrary to the express disclosure of EDWARDS to make the splash guard something other than flexible. Indeed, in column 2, lines 48-51, EDWARDS explains that "the guard extends across the entire instep portion of the boot 10, but it leaves a considerable length above the instep portion unprotected at the front of the boot." Further, in column 3, lines 28, to column 4, line 2 (claim 1), EDWARDS explains that the *rigid* instep guard terminates at the "upper extreme of the instep portion of the boot" and that the *flexible* splash guard is connected to the upper end of the rigid instep guard.

Therefore, in contrast to the conclusion advanced in the final rejection based upon a

combination of EDWARDS and CATAFFO, it would not have been obvious to have modified EDWARDS' *flexible* splash guard with the *rigid* shield of CATAFFO.

Accordingly, all rejections which employ the combination of EDWARDS and CATAFFO should be withdrawn.

**3. Applicant's Invention is Neither Anticipated Nor Rendered Obvious by ELLIS, EDWARDS, or O'DONNELL**

Applicant requests reconsideration and withdrawal of the rejections of independent claims 14 and 15, as well as claims depending therefrom. None of ELLIS, EDWARDS, and O'DONNELL, nor combinations thereof, including the addition of the teachings of CATAFFO and LANDRY, teach or suggest Applicant's invention.

First, even when considered without the amendments proposed above to independent claims 14 and 15, Applicant submits that the rejections fall short of evidencing the anticipation or obviousness of the claimed invention.

Second, in independent claims 14 and 15, Applicant has proposed an amendment above in which the cover is said to be fixed to the sole and fixed to the upper. The fixing of the cover to the upper encompasses the straps 13 shown in Figs. 4 and 5, which are of the removable type, as disclosed.

In addition, claims 14 and 15 have been amended to further specify that the flexion that is described as being stiffened by the device recited is in the *flexion fold zone*. By contrast, as Applicant has explained in prior replies, none of the guard flap patents (such as those of ELLIS, EDWARDS, and O'DONNELL) are intended to prohibit flexing at the flexion fold (*i.e.*, or flexion "crease"). In fact, the rearward extents of the guard flaps terminate at a point so that such flexion can occur to enable walking.

However, it is the flexure at the flexion fold which Applicant's invention is intended to affect, *i.e.*, to rigidify to some extent.

**SUMMARY AND CONCLUSION**

Entry of the amendment is requested, together with reconsideration and withdrawal of the rejections for reasons of record and for additional reasons advanced above.

No fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Further, although no extension of time is believed to be necessary at this time, if it were to be found that an extension of time were necessary to render this reply timely and/or complete, Applicant requests an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) that would render this reply timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,  
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